

REMARKS

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Applicant respectfully requests reconsideration of this application as amended.

Claims 1-25 are pending in the application. No claims have been amended.

The Examiner rejected claims 1-2, 4-6, 10-14, 16, and 20-25 under 35 U.S.C. §103(a) as being unpatentable over Magnus et al. (WO 02/082359; hereinafter "Magnus") as modified by Zdybel, Jr. et al. (US 5,486,686; hereinafter "Zdybel, Jr.").

Applicant respectfully traverses the rejection.

With respect to claim 1, Applicant respectfully submits that the present invention as taught by claim 1 includes "automatically sending the one or more edits made on the hardcopy representation, via wireless transmission, to a computer system" (claim 1, emphasis added). In contrast, the writing and reading unit disclosed in Magnus does not automatically send edits to a computer system. According to Magnus, to send edits from the writing and reading unit, a user has to actuate a send button, to move the writing and reading unit across a specific place, or to mark a specific send box on the coupon (Magnus, p. 3, lines 8-17; p. 8, lines 15-17). Therefore, Magnus does not disclose all the limitations of claim 1. Zdybel, Jr. does not overcome the deficiency of Magnus. That is, Zdybel, Jr. does not disclose "automatically sending the one or more edits made on the hardcopy representation, via wireless transmission, to a computer system." Since the combination of Magnus and Zdybel, Jr. does not disclose every limitation in claim 1, they do not render claim 1 obvious under §103(a). Applicant respectfully requests the Examiner to withdraw the rejection.

Since Magnus and Zdybel, Jr. do not disclose every limitation in claim 1, it is not necessary to discuss whether one of ordinary skill in the art would be motivated to combine Magnus and Zdybel, Jr., and therefore, this issue is not discussed here. However, Applicant reserves the right to argue this issue in the future.

Claims 2-25 depend, directly or indirectly, from claim 1. For at least the reason discussed above with respect to claim 1, claims 2-25 are patentable over Magnus in view of Zdybel, Jr. Applicant respectfully requests the Examiner to withdraw the rejections.

With respect to claims 7-9, and 17-19, the Examiner rejected them under 35 U.S.C. §103(a) as being unpatentable over Magnus, as modified by Zdybel, Jr. as applied to claim 1, and further in view of Patton et al. (US 5,757,468; hereinafter "Patton"). For the reasons discussed above with respect to claim 1, and at least one additional reason, Applicant respectfully traverses the rejection.

Applicant respectfully submits that there is no motivation for one of ordinary skill in the art to combine Patton with Magnus and Zdybel, Jr. to come up with the present invention as claimed in claims 7-9, and 17-19. Patton is directed to associating sound with still images (Patton, column 1, lines 15-20), not updating an electronic application with edits made to hardcopy representations of the electronic application. Applicant respectfully submits that Patton is directed to a distinct and separate problem from the one solved by the present invention as claimed, and therefore, one of ordinary skill in the art would not have been motivated to look to Patton for a solution to the problem identified in the present application. In view of this, Applicant respectfully submits that the present invention as claimed is not obvious in view of Magnus, Zdybel, Jr., and Patton. Applicant respectfully requests the Examiner to withdraw the rejection under §103(a).

Accordingly, Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been overcome by the remarks and withdrawal of these rejections is respectfully requested. Applicant submits that claims 1-25 are now in condition for allowance and such action is earnestly solicited.

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Respectfully submitted,  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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CZD  
Chui-kiu Teresa Wong  
Attorney for Applicant  
Registration No. 48,042

12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, CA 90025-1026  
(408) 720-8598

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Date